

REMARKS

In the Office Action¹, the Examiner rejected claims 1, 3, 4, 7-13, and 21-23 under 35 U.S.C. § 103(a) as unpatentable over admitted prior art in view of U.S. Patent No. 6,044,362 to Neely ("Neely") and U.S. Patent Application Publication No. 2002/0062240 to Morinville ("Morinville"). Applicants respectfully traverse this rejection for the following reasons.

As a preliminary matter, Applicants respectfully refer the Examiner to M.P.E.P. § 706.02(j), which states that the examiner should set forth "the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s)" (emphasis added). Moreover, 37 C.F.R. § 1.104(c)(2) states, "when a reference is complex or shows or describes other inventions other than that claimed by applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." (emphasis added). As the Examiner rejects the claims of this application under 35 U.S.C. § 103(a), Applicants submit that each reference applied by the Examiner necessarily describes inventions other than those claimed by Applicants. Therefore, the Examiner is required to designate the part of the references relied upon "as nearly as practicable." Moreover, the Examiner is required to do so for "each rejected claim."

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

The Examiner has not complied with the M.P.E.P., or with 37 C.F.R. § 1.104(c)(2). Throughout the Office Action, the Examiner declines to cite with particularity to the prior art. Moreover, the Examiner fails to even distinguish between independent claims 1, 7, 10, 13, and 21, which do not recite identical subject matter. In addition, the Examiner fails to address any of the dependent claims. Applicants respectfully request that the Examiner identify the relevant teachings of the references as they pertain to the claimed invention, as required by the M.P.E.P. and by 37 C.F.R. § 1.104(c)(2).

With respect to the alleged “admitted prior art,” the Examiner makes the broad and erroneous assertion that “[t]he admitted prior art shows all of the limitations of the claims except for specifying a response disputing one or more line items and the specifics of the approvers from the purchasing entity” (Office Action at p. 2). This sweeping allegation is entirely unsupported by Applicants’ description of the background of the invention. Indeed, the Examiner does not cite with particularity to Applicants’ specification in identifying any claim limitation. Instead, the Examiner merely quotes pp. 2-3 of the specification without identifying how the specification can be read to disclose “admitted prior art” against the claims of this application. Applicants respectfully request that the Examiner cite the specification for the alleged “admitted prior art” with the specificity required by the M.P.E.P. and 37 C.F.R. § 1.104(c)(2) as discussed above.

Further, the Examiner has not established that *Morinville* is prior art against the claims of this application. As discussed on p. 2 of the Reply to Office Action filed October 26, 2007, *Morinville* is a CIP of the ‘163 application, and therefore there is new

matter present in *Morinville*. According to 37 C.F.R. § 1.104(c), the “pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” It is not apparent what subject matter disclosed in *Morinville* qualifies for the priority date of the ‘163 application. The Examiner has provided limited access to the ‘163 application, thus preventing Applicants from being able to challenge the Examiner’s position as to what subject matter of *Morinville* is supported by the earlier filing. Therefore, the Examiner’s reliance on *Morinville* as prior art against this application is improper. Moreover, Applicants note that the portions of the ‘163 application provided by the Examiner, i.e. Fig. 1 and the text of page 1, do not appear in *Morinville*.

In addition to the above-noted deficiencies in the Office Action, a *prima facie* case of obviousness has not been established because, among other things, none of Applicants’ alleged admitted prior art, *Neely*, and *Morinville*, taken alone or in combination, teach or suggest each and every element recited by Applicants’ claims. Independent claim 10 recites, for example, a computer-implemented method for performing dispute resolution in a system including a providing entity and a purchasing entity, the method comprising “receiving an indication by the first approver reflecting a selection of [a] first invoice, wherein the first invoice includes at least a first line item and a second line item that have been reviewed by the second approver, the first line item being disputed and the second line item being approved by the second approver.” The cited references fail to teach or suggest at least a “first invoice includ[ing] … [a] first line item being disputed and [a] second line item being approved by [a] second approver.”

Applicants' specification identifies this subject matter as manifestly not taught by the prior art, stating: "[a]lthough such [prior art] services enable businesses to perform invoice processes electronically, dispute and payment processing is limited to the entire invoice. That is, if the purchaser disputed a particular line item within an invoice, the entire invoice would have to be disputed" (Specification at p. 3). *Neely* is consistent with the prior art as discussed in the specification. *Neely* states: "customer 20 may be provided with any combination of the following options: 1) The customer may pay less than the amount due on the invoice ... for a specific reason such as a dispute concerning a line item contained on the invoice" (*Neely* col. 5, lines 4-9). *Neely* thus discloses disputing an entire invoice by not paying the full amount for the invoice, and does not disclose that the invoice contains an approved line item and a disputed line item. Therefore, *Neely* fails to teach or suggest the claimed "first invoice includ[ing] ... [a] first line item being disputed and [a] second line item being approved by [a] second approver."

Morinville fails to cure the deficiencies of the admitted prior art and *Neely*.

Morinville discloses a system for approval of business processes where the approving managers are identified, and "[i]f two management levels are necessary for approval, the first level manager and the second level manager would be identified" (*Morinville*, ¶ 69). *Morinville*, however, fails to disclose an invoice containing a disputed line item and an approved line item. Therefore, *Morinville* fails to teach or suggest the claimed "first invoice includ[ing] ... [a] first line item being disputed and [a] second line item being approved by [a] second approver."

Accordingly, Applicants' admitted prior art, *Neely*, and *Morinville* fail to establish a *prima facie* case of obviousness with respect to claim 10, at least because the references fail to teach or suggest each and every element of the claim. Independent claims 1, 7, 13, and 21, though of different scope from claim 10, recite limitations similar to those set forth above with respect to claim 10. Claims 3 and 4 depend from claim 1, claims 8 and 9 depend from claim 7, claims 11 and 12 depend from claim 13, and claims 22 and 23 depend from claim 21, and are therefore allowable at least due to their dependence from allowable base claims.

Dependent claim 3 further distinguishes the cited references. Dependent claim 3 recites "displaying, on a display device, an indication that the second approver has disputed the first line item and approved the second line item included in the first invoice." As discussed, the cited references fail to disclose a "first invoice includ[ing] ... [a] first line item being disputed and [a] second line item being approved by [a] second approver." Therefore, the references necessarily fail to teach or suggest displaying an indication that a first line item is disputed and a second line item is approved.

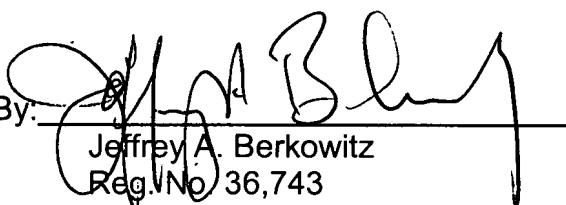
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

Dated: August 29, 2007

By: 
Jeffrey A. Berkowitz
Reg. No. 36,743